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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,739	12/20/2001	Achim Link	4452-441	3791

7590 03/12/2003
Thomas C. Pontani, Esq.
Cohen, Pontani, Lieberman & Pavane
Suite 1210
551 Fifth Avenue
New York, NY 10176

EXAMINER

YEE, DEBORAH

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 03/12/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/027,739

Applicant(s)

LINK ET AL.

Examiner

Deborah Yee

Art Unit

1742

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Clark (US Patent No. 4,230,506).

Clark discloses a gray cast iron alloy on lines 10 to 19 in column 3 which meets the claimed composition. Even though prior art does not teach using alloy for a friction clutch as recited by the claim, such would not be a patentable distinction since it is merely applicant's future and intended use.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 to 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark (US patent No.4,230,506), European patent 360254, English abstract of Russian patent '873, or English abstract of Russian patent '123.

Clark in lines 20 to 34 of column 2, EP'254 in claim 2 on page 8, English abstract of Russian '873 and Russian '123, each disclose a gray cast iron alloy with constituents

whose wt% ranges overlap or closely approximate those recited by the claims. The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the ranges disclosed by the prior art because close approximation or overlapping ranges have been held to establish a prima facie case of obviousness, see *Titanium Metal v. Banner*, 227USPQ773, in re *Malagari*, 182USPQ549, and MPEP2110.01.

Moreover, note that EP'254 discloses a lower carbon limit of 3.5% which is slightly higher than applicant's upper carbon limit of 3.4%. Since applicant has not demonstrated criticality of the upper carbon limit (e.g. by comparative test data), then it would seem that composition with 3.4%carbon vs. a composition with slightly more (3.5%)carbon would depict a mere difference in the proportion of element without any attendant unexpected results which would not patentably distinguish the claims over the prior art.

Even though prior art alloys contain additional elements (Cu, Ti, Ca, Sb,V, REM) not recited by the claims, such elements would not be excluded from the claims which recite "contains". Note that the term "contains" opens the claim to any unrecited element even in major amounts.

The prior art , in general, teaches a friction device which would broadly include devices in the shape of plate or wheel. Even though prior art does not specifically teach a friction element for a friction clutch, such would not be a patentable distinction since it is merely applicant's future and intended use.

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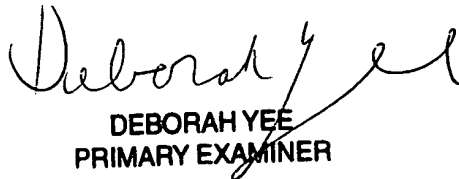
In regard to process limitations, the prior art does not teach stress-relief annealing as recited in claims 6 to 13. Since claims are directed to a product, then patentability in a product-by-process claim is determined by the product per se and not the process. Applicant will have the burden to show that the prior art products do not necessarily or inherently possess the characteristics of the claimed product.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 703-308-1102. The examiner can normally be reached on Monday-Friday from 6:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 703-308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-873-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

dy
February 26, 2003


DEBORAH YEE
PRIMARY EXAMINER